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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,289	01/26/2001	Gottfried von Bismarck	31653-167874 RK	4823

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VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP  
P.O. BOX 34385  
WASHINGTON, DC 20043-9998

EXAMINER

LE, UYEN CHAU N

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/769,289

Applicant(s)

BISMARCK ET AL.

Examiner

Uyen-Chau N. Le

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14 is/are allowed.
- 6) ☒ Claim(s) 15-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Prelim. Amdt/Amendment*

1. Receipt is acknowledged of the Amendment filed 30 June 2003.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 15-22 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Lephardt (US 4,836,378) in view of Rudszinat (US 4,077,289) and Bryant et al (US 5,190,428).

Re claims 15-22: Lephardt discloses a method of confining a commodity 34 in a composite container 12 having a plurality of constituents, comprising assembling the constituents into the composite container 12 around the commodity 34; processing information and encoding

Art Unit: 2876

the information, which can be decoded without even partial opening of the assembled container 12; the container including an inner envelope directly surrounding the commodity 34; an outer envelope 14 surrounding the inner envelope; a tear strip 16 borne by the outermost envelope 14 (figs. 1 & 3; col. 3, line 7 through col. 4, line 28).

Lephardt fails to teach or fairly suggest the step of providing characteristic indicia, which is randomly selected and is processed into information.

Rudszinat teaches the above limitation with indicia being printed on label 3, which is detachable insert forming part of the inner envelope (col. 3, lines 4-9; col. 5, lines 23-40).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Rudszinat into the teachings of Lephardt in order to provide Lephardt with a simpler and more feasible system, wherein the characteristic indicia is easier to print (i.e., does not require special ink - e.g., jet ink). Furthermore, such modification would have mere been a substitution of equivalents well within the ordinary skill in the art, and therefore an obvious expedient.

Lephardt as modified by Rudszinat fails to teach or fairly suggest means for conveying successive commodities of the series along a predetermined path.

Bryant et al teaches the above limitation with commodities being conveyed by conveyor path 12 (figs. 1 & 2; col. 6, lines 1-15).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bryant et al into the teachings of Lephardt/Rudszinat in order to provide Lephardt/Rudszinat with a more feasible system (i.e., reducing the requirements of laborers). Furthermore, such modification would provide

Art Unit: 2876

Lephardt/Rudszinat with a faster and productive system. Accordingly, such modification would have been an obvious extension as taught by Lephardt/Rudszinat, well within the ordinary skill in the art, and therefore an obvious expedient.

***Allowable Subject Matter***

4. Claims 1-14 are allowed.

5. The following is a statement of reasons for the indication of allowable subject matter: The prior art of records to Lephardt, Rudszinat, Bryant et al and all other cited references, taken alone or in combination, fails to teach or fairly suggest the specific method of confining a commodity in a composite container having a plurality of constituents comprising, among other steps, providing at least some of the constituents with characteristics indicia and processing the characteristic indicia into information which is characteristic of the composite container as set forth in the claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Response to Arguments***

6. Applicant's arguments filed 30 June 2003 have been fully considered but they are not persuasive.

Art Unit: 2876

7. In response to the Applicant's argument with reference to p. 5-6, the examiner respectfully requests the applicant to review Lephardt, wherein the claim 15 does not necessary claim applying to each constituent individually merely providing indicia to "at least some," which happens by providing indicia to all by marking the box/container (Lephardt: col. 3, line 58 through col. 4, line 20). Therefore, given its broadest interpretation, the cigarettes packaging system as taught by Lephardt in view of Rudszinat and Bryant et al meets the claimed invention.

8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., each individual pack to be identified and encoded to prevent package forgery (p. 5)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2876

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588.

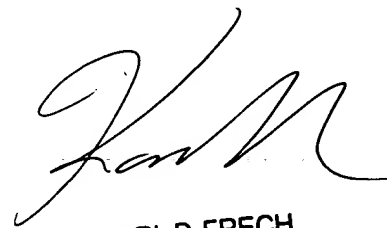
The examiner can normally be reached on SUN, M, W, F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

*Uyen-Chau N. Le*

*Sep. 10, 2003*



KARL D. FRECH  
PRIMARY EXAMINER